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Remarks

Claims 1, 24, 26 and 51 have been amended. Claims 2, 3, 27, 28, and 50 have been cancelled without prejudice. Applicants retain the right to pursue claims 1, 26 and 50 in their original form in a continuing application. Claims 24 and 51 have been amended to correct clerical errors and not for reasons related to patentability. Support for the amendments to the claims can be found in general throughout Applicants' Specification and in particular, for example, as follows: claim 1, original claims 2 and 3, claim 26 original claims 27 and 28. No new matter has been added.

Claims 1, 4, 6, 9-23, and 25 stand rejected under 35 U.S.C. § 102(e) over Liu (U.S. Patent No. 6,084,008).

Liu discloses a fire retardant coating composition that includes expandable graphite particles, a solid absorbent material, a polymeric binder, a carbonific material, a blowing agent, a solvent, and a rheology modifier.

Claim 1 is now directed to an aqueous fire barrier composition that includes a latex that includes a polymer, from 1 % by weight to about 10 % by weight polyol having 2, 3 or 4 hydroxy groups and a molecular weight of from 100 to about 1200, the polyol being selected from the group consisting of polyethylene glycol, polypropylene glycol, and combinations thereof, and an intumescent agent. Liu does not teach a composition that includes from 1 % by weight to about 10 % by weight polyol having a molecular weight of from 100 to about 1200 and selected from the group consisting of polyethylene glycol, polypropylene glycol, and combinations thereof. Accordingly, Applicants submit that the rejection of claim 1 under 35 U.S.C. § 102(e) over Liu has been overcome, and request that it be withdrawn.

Claims 4, 6, 9-23, and 25 are distinguishable under 35 U.S.C. § 102(e) over Liu for at least the same reasons set forth above in distinguishing claim 1.

Claim 5 stands rejected under 35 U.S.C. § 102(e) or in the alternative under 35 U.S.C. § 103 over Liu (U.S. Patent No. 6,084,008).

Applicants submit that the amendments to claim 1 render moot the rejection of claim 5 under 35 U.S.C. § 102(e) or in the alternative under 35 U.S.C. § 103 over Liu, and request that it be withdrawn.

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Claims 7-8, 24, 26, 29-49, and 51 stand rejected under 35 U.S.C. § 103 over Liu in view of Gestner et al. (U.S. 5,175,197).

The disclosure of Liu set forth above is incorporated herein.

Gestner et al. disclose a water-based intumescent fire barrier caulk.

Applicants submit that the amendments to claim 1 render moot the rejection of claims 7-8 and 24 under 35 U.S.C. § 103 over Liu in view of Gestner et al.

Claim 26 is now directed to an aqueous fire barrier composition that includes latex that includes a polymer, from 1 % by weight to about 10 % by weight polyol having 2, 3 or 4 hydroxy groups, the polyol being selected from the group consisting of ethylene glycol, polypropylene glycol, glycerol and combinations thereof, and an intumescent agent. The intumescent agent includes a composition that includes granular alkali metal silicate represented by the formula  $M_2O:XSiO_2$  in which M is an alkali metal, at least one oxyboron compound selected from the group consisting of boric acid and borate salts of Group I and group II elements, and water bound to the alkali metal silicate, the weight ratio X ranging from about 1.5 to about 4, the molar ratio of boron to M being from about 0.2 to about 0.9, and the water being about 5 % to about 15 % of the total granule weight. To establish a *prima facie* case of obviousness based upon a proposed combination of references there must be a teaching, suggestion or motivation in the prior art for making the proposed combination. See M.P.E.P. 2142; *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437 (Fed. Cir. 1997). Here there is no such teaching, suggestion or motivation. Liu does not teach ethylene glycol, polypropylene glycol, or glycerol.

Gestner et al. do not cure the deficiencies of Liu. Gestner et al. do not teach or suggest anything about polyols –let alone ethylene glycol, polypropylene glycol, or glycerol. The proposed combination of Liu and Gestner et al. thus lacks a required element of claim 26. Applicants submit, therefore, that the rejection of claim 26 under 35 U.S.C. § 103 over Liu in view of Gestner et al. has been overcome and request that it be withdrawn.

Claims 29-49 are distinguishable under 35 U.S.C. § 103 over Liu in view of Gestner et al. for at least the same reasons set forth above in distinguishing claim 26.

Claim 51 is directed to an aqueous fire barrier composition that includes a) 40 % by weight to 45 % by weight latex comprising acrylate-vinylacetate-ethylene terpolymer,

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b) 1 % by weight to 3 % by weight polyethylene glycol having a molecular weight from about 100 to about 500, c) 15 % by weight to 25 % by weight intumescent agent comprising a composition comprising granular alkali metal silicate represented by the formula  $M_2O:XSiO_2$  in which M is an alkali metal, at least one oxyboron compound selected from the group consisting of boric acid and borate salts of Group I and group II elements, and water bound to said alkali metal silicate, the weight ratio X ranging from about 1.5 to about 4, the molar ratio of boron to M being from about 0.2 to about 0.9, and the water being about 5% to about 15% of the total granule weight; and d) 18 % by weight to 27 % by weight zinc borate. Neither Liu nor Gestner et al. teach polyethylene glycol having a molecular weight from about 100 to about 500. Therefore, the proposed combination of Liu and Gestner et al. lacks a required element of claim 51. Accordingly, a *prima facie* case of obviousness of claim 51 over Liu and Gestner has not been established. Applicants submit, therefore, that the rejection of claim 51 under 35 U.S.C. § 103 over Liu in view of Gestner et al. has been overcome and request that it be withdrawn. Should this rejection be maintained, Applicants respectfully request that the next action identify, by reference to column and line number, the location in either Liu or Gestner et al. of a teaching of polyethylene glycol.

Applicants submit that the amendment to claim 1 renders moot the rejection of claims 1, 6, 9-21, and 23 under 35 U.S.C. § 102(b) over Hill (U.S. 5,225,464), the rejection of claims 4, 5, 22, and 25 under 35 U.S.C. § 102(b) or alternatively under 35 U.S.C. § 103 over Hill, and the rejection of claims 7, 8, and 24 under 35 U.S.C. § 103 over Hill in view of Gestner et al.

Claims 26, 29-49, and 51 stand rejected under 35 U.S.C. § 103 over Hill in view of Gestner et al.

Hill discloses an intumescent coating that is asserted to produce a hard, vitreous, insulating char when exposed to heat and flame. Hill discloses that his compositions swell and vitrify upon exposure to flame and heat and that the formation of the vitreous char is favored when materials that decompose to form dehydrating acids, such as phosphates, polyphosphates or pyrophosphates, are utilized.

The discussion of Gestner et al. set forth above is incorporated herein.

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Claim 26 requires the presence of ethylene glycol, polypropylene glycol, or glycerol. Hill does not teach ethylene glycol, polypropylene glycol, or glycerol.

Gestner et al. do not cure the deficiencies of Hill. Gestner et al. do not teach or suggest ethylene glycol, polypropylene glycol, or glycerol. Accordingly, the proposed combination of Hill and Gestner et al. lacks a required element of claim 26. Applicants submit, therefore, that the rejection of claim 26 under 35 U.S.C. § 103 over Hill in view of Gestner et al. has been overcome, and request that it be withdrawn.

Claims 29-49 are distinguishable under 35 U.S.C. § 103 over Hill in view of Gestner et al. for at least the same reasons set forth above in distinguishing claim 26.

Claim 51 requires the presence of from 1 % to 3 % by weight polyethylene glycol having a molecular weight from about 100 to about 500. Neither Hill nor Gestner teach or suggest polyethylene glycol. Thus, the proposed combination of Hill and Gestner lacks a required element of claim 51. Accordingly, a *prima facie* case of obviousness of claim 51 over the proposed combination of Hill and Gestner has not been established. Applicants submit, therefore, that the rejection of claim 51 under 35 U.S.C. § 103 over Hill in view of Gestner et al. has been overcome and request that it be withdrawn. Should this rejection be maintained, Applicants respectfully request that the next action identify, by reference to column and line number, the location in either Hill or Gestner et al. of a teaching of polyethylene glycol.

Applicants submit that the amendments to claim 1 render moot the rejection of claim 1, 4, 5, 9-22 and 25 under 35 U.S.C. § 102(b) over Pedlow, and request that it be withdrawn.

Applicants submit that the amendments to claim 1 also render moot the rejection of claims 6-8 under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103 over Pedlow, as well as the rejection of claim 24 under 35 U.S.C. § 103 over Pedlow in view of Gestner et al.

Claims 26, 29-49, and 51 stand rejected under 35 U.S.C. § 103 over Pedlow in view of Gestner et al.

Pedlow discloses a fire protective mastic and fire stop for electrical cables and neighboring wall junctures or partitions through which the cables pass.

The discussion of Gestner et al. set forth above is incorporated herein.

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Claim 26 is directed to an aqueous fire barrier composition that includes a polyol selected from the group consisting of ethylene glycol, polypropylene glycol, or glycerol. Neither Pedlow nor Gestner et al. teach or suggest including ethylene glycol, polypropylene glycol, or glycerol in a fire barrier composition. Accordingly, the proposed combination of Pedlow and Gestner et al. lacks a required element of claim 26. Applicants submit, therefore, that the rejection of claim 26 under 35 U.S.C. § 103 over Pedlow in view of Gestner et al. has been overcome, and request that it be withdrawn.

Claims 29-49 are distinguishable over the proposed combination of Pedlow and Gestner et al. for at least the same reasons set forth above in distinguishing claim 26.

Claim 51 requires the presence of polyethylene glycol. Neither Pedlow nor Gestner et al. teach polyethylene glycol. Pedlow and Gestner et al. also do not suggest including polyethylene glycol in an aqueous fire barrier composition. Accordingly, the proposed combination of Pedlow and Gestner et al. lacks a required element of claim 51. Applicants submit, therefore, that a *prima facie* case of obviousness has not been established. The rejection of claim 51 under 35 U.S.C. § 103 over Pedlow in view of Gestner et al. has thus been overcome, and Applicants request that it be withdrawn. Should this rejection be maintained, Applicants respectfully request that the next action identify, by reference to column and line number, the location in Pedlow or Gestner et al. of a teaching of polyethylene glycol.

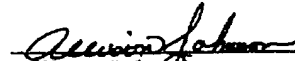
The claims now pending in the application are in condition for allowance and such action is respectfully requested. If the next action is other than an allowance, Applicants respectfully request that the Examiner telephone the undersigned for a teleconference interview.

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Please charge any additional fees that may be required or credit any overpayment made to Deposit Account No. 501,171.

Respectfully submitted,

Date: October 5, 2005

  
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